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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/674,639      | 01/08/2001  | Carmel Soffer        | P-1660-US           | 8906             |

7590 07/16/2003

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[REDACTED] EXAMINER

EWART, JAMES D

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 2683     |              |

DATE MAILED: 07/16/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/674,639             | SOFFER ET AL.       |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | James D Ewart          | 2683                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on \_\_\_\_\_.
- 2a) This action is FINAL.      2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-30 is/are pending in the application.
  - 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-30 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.
 

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.
 

If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) All b) Some \* c) None of:
    1. Certified copies of the priority documents have been received.
    2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
  - a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                          | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____  |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                 | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4. | 6) <input type="checkbox"/> Other:  |

*Specification*

1. This application does not contain an abstract of the disclosure as required by 37 CFR 1.72(b). An abstract on a separate sheet is required.

*Claim Rejections - 35 USC § 102*

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

2. Claims 1 – 7, 9 – 22, and 24 - 30 are rejected under 35 U.S.C. 102(e) as being anticipated by Joong et al (U.S. Patent No. 6,188,887).

Referring to claims 1 and 17, Joong et al teaches a system for providing a roaming subscriber with access to services available in a first telephone network (Column 3, Lines 1- 4), said subscriber roaming in a second telephone network (Figure 1), the system comprising: a packet-switch network connecting said first telephone network with said second telephone

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network (Figure 1; 50 and Column 8, Lines 46-58), wherein signals required for said services are transmitted between said first telephone network and said second telephone network via said packet-switch network (Column 8, Lines 46-58 and Column 9 Lines 31-51).

Referring to claims 2, 3, 18, and 19, Joong et al further teaches wherein network is one of a group including: a mobile telephone network, a fixed telephone network, a Global System for Mobile communications (GSM) network, a Time Division Multiple Access (TDIVIA) network, a Code Division Multiple Access (CDMA) network, an IS-41 network, and a private branch exchange (PBX) (Figure 1).

Referring to claims 4 and 20, Joong et al further teaches a passive System Signaling Number 7 (SS7) monitor for monitoring SS7 signals and triggering the provision of access to at least one of said services when one of a group of predetermined SS7 signals has been detected (Column 8, Lines 46-51).

Referring to claims 5 and 21, Joong et al further teaches wherein said predetermined SS7 signals are Mobile Application Part (MAP) messages (Column 8, Line 51). MAP messages are a part of SS7 for mobile phones, therefore when discussing SS7 is essentially the same as discussing MAP messages when in a mobile environment

Referring to claims 6 and 22, Joong et al further teaches wherein said messages are from a group including: short messages and location updates (Column 8, Lines 49-50).

Referring to claim 7, Joong et al further teaches a first service node for transmitting said signals between said first telephone network and said packet-switch network; and a second service node for transmitting said signals between said packet-switch network and said second telephone network (Figure 1; 30, 50 and Column 3, Line 49).

Referring to claims 9 and 24, Joong et al further teaches wherein said subscriber uses a short code dependent upon the location of said subscriber to access said second service node (Column 3, Lines 47-50). The message could be sent to either the first or second node.

Referring to claim 10, Joong et al further teaches wherein said first service node instructs said second service node via said packet switch network to generate and send a short message (Column 8, Lines 46-58).

Referring to claims 11 and 25, Joong et al further teaches a user profile of said subscriber, said user profile comprising at least a subscriber calling line identification (CLI) wherein said subscriber CLI is required for access to said services (Column 9, Lines 25-30).

Referring to claims 12 and 26, Joong et al further teaches wherein said second service node receives said subscriber CLI from DTMF-signals-sent by said subscriber (Column 9, Lines 25-30).

Referring to claims 13 and 27, Joong et al further teaches wherein said second service node receives a second CLI from said second telephone network and said second CLI is associated with said subscriber CLI (Column 9, Lines 25-30).

Referring to claims 14 and 28, Joong et al further teaches wherein said second service node creates a voice path connecting said second telephone network with said first telephone network using a second CLI of said second service node, and wherein said first service node replaces said second CLI with said subscriber CLI when accessing one of said services (Column 9, Lines 25-30).

Referring to claims 15 and 29, Joong et al further teaches wherein said services include voice message notification (Column 3, Lines 12-14).

Referring to claims 16 and 30, Joong et al further teaches wherein said services include voice message retrieval (Column 3, Lines 12-14).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 8 and 23 are rejected under 35 USC 103(a) as being unpatentable over Joong et al and further in view of Comer (U.S. Patent No. 5,588,042).

Referring to claims 8 and 23. Joong et al further teaches the limitations of claims 8 and 23, but does not teach wherein said second service node transmits dial tone multi-frequency (DTMF) signals substantially concurrently with the creation of a voice path connecting said first telephone network with said second telephone network, and said first service node synchronizes said DTMF signals with said voice path. Comer teaches wherein said second service node transmits dial tone multi-frequency (DTMF) signals substantially concurrently with the creation of a voice path connecting said first telephone network with said second telephone network, and said first service node synchronizes said DTMF signals with said voice path (Column 9, Lines 14-42). Therefore at the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine the art of Joong et al with the art of Comer of wherein said second service node transmits dial tone multi-frequency (DTMF) signals substantially concurrently with the creation of a voice path connecting said first telephone network with said second telephone network, and said first service node synchronizes said DTMF signals with said voice path to receive touch tone responses from customers as inputs (Column 9, Lines 15-16).

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Allen et al. U.S. Patent No. 5,313,515 discloses a call completion system with message writing indication upon registration of mobile with basestation.

Amin U.S. Patent No. 6,014,559 discloses method and system for delivering a voice mail notification to a private base station using a cellular phone network.

Beyda et al U.S. Patent No. 5,889,839 discloses a system and method for providing automated message notification in a wireless communication system.

Coyne et al. U.S. Patent No. 5,943,619 discloses a shared interworking of subscriber features within mobile telecommunications networks.

Curry et al U.S. Patent No. 6,181,695 discloses telecommunications network.

Hayes et al U.S. Patent No. 5,506,888 discloses auxillary communication service routing.

Hauser et al U.S. Patent No. 5,734,700 discloses system for call forwarding from a first communication network to a second remote communication network and a system for virtual extension of a mobile communication network by at least a second remote communication network.

Hulen et al. U.S. Patent No. 5,497,373 discloses multi-media interface.

LaRocca U.S. Patent No. 6,069,888 discloses integrating voice mail system for CDMA network.

McAllister U.S. Patent No. 6,317,484 discloses personal telephone service with transportable script control of services.

Ranta U.S. Patent No. 6,337,977 discloses roving voice mail.

Rieley et al U.S. Patent No. 6,208,638 discloses method and apparatus for transmission and retrieval of facsimile and audio messages over a circuit or packet switched network.

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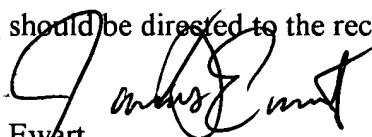
White et al U.S. Patent No. 6,243,374 discloses telecommunications custom calling services using voice mail.

Zhu et al U.S. Patent No. 6,226,373 discloses intelligent service peripheral / intelligent peripheral.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to James D Ewart whose telephone number is (703) 305-4826. The examiner can normally be reached on M-F 7am - 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, William Trost can be reached on (703)308-5318. The fax phone numbers for the organization where this application or proceeding is assigned are (703)305-9508 for regular communications and (703)305-9508 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)305-3900.

  
Ewart  
July 9, 2003

  
WILLIAM TROST  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600